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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,426	10/17/2000	David S. Cortright	MCS-020-99	3341

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EXAMINER

TRAN, LAMBERT L

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,426

Applicant(s)

CORTRIGHT ET AL.

Examiner

Lambert L. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Amendment A, received on 03 November 2003, has been entered as Paper #7.
2. Claims 1, 3, 9, 10, 17, 18, 24, 25 are amended.
3. Claims 1-25 remain pending.

Priority

4. No claim for priority has been made in this application.

Drawings

5. The amended drawings and their respective references in the amended disclosure are acceptable for examination purposes.

Claim Rejections - 35 USC § 112

6. The currently amended claims 9 and 10 (Amendment A, Paper #7, Page 5 and Page 6) have sufficiently overcome the 35 USC 112 rejection, second paragraph, previously held as being indefinite for failing to particularly point out and distinctly claim the subject matter. The rejection is therefore removed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer et al., U.S. Patent No 6349299, hereinafter referred to as Spencer, in view of Holtz, U.S. Patent No 6433800.

9. Referring to claim 1, 24, 25, Spencer discloses a System And Method For Storing Electronic Contact Information Into An Electronic Address Book, wherein *a computer-implemented process for allowing a user to manipulate an email address contained in the preview pane or full message window of an email message of an email program as an object* [see Spencer, ABSTRACT, Figure 4, col.9, lines 6-13), *comprising using a computer to perform the following acts:*

Identifying/recognizing an entry in the preview pane or full message window of an email message as an email address [see Spencer, col. 5, lines 13-19);

and

upon selection of the indicator by the user, allowing the user to manipulate the email address as an object [see col. 7, lines 8-31, col. 8 7, lines 8-31, col. 8, lines 46-53]

However, Spencer does not disclose:

marking the email address with an adjacently placed indicator;

In the same field of endeavor, Holtz reference discloses graphical action invocation method providing iconic representations of actions available to be performed upon an object of a particular data type, such as address of an email message [see Holtz, ABSTRACT, and col. 3, lines 8-10, col. 3, lines 13-15]. An ordinary artisan in the art at the same time the invention was

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made, would have been motivated to look to a way to reduce the operation time on maintaining email address [see Spencer col. 1, lines 45-53].

10. Accordingly, it would have been obvious to one of ordinary skill in the software programming art at the time the invention was made to have incorporated Holtz's teachings of graphical action invocation method through iconic presentation [see Holtz, col. 2, lines 55-64] with the teachings of Spencer's, for the purpose of providing a system that is more intuitive, ease of user interaction with the computer [see Holtz, col. 1, lines 63-65].

11. As per claims 24 and 25, these claims describe computer code and a system that implement the method of claim 1. They are rejected using the same rationale.

12. In regards to claim 2, Spencer discloses:

finding at least one field in the preview pane or full message window containing an email message header of the email message containing one or more email addresses [see Spencer, col. 4, lines 19, col. 4 lines 56-60]; and parsing at least one email address from the at least one email address field [see Spencer, col. 3, lines 51-65, col. 5, lines 13-19].

13. In regards to claim 3, Spencer discloses:

checking the email address against addresses in one or more contact

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databases to determine if it is contained in a contact database, wherein a contact database is a set of stored contacts and corresponding addresses [see Spencer, col. 6, lines 14-48, col. 8, lines 31-53].

14. In regards to claim 4, Spencer discloses an Electronic address book interface module [see Spencer, figure 2, col. 6, lines 25-35]. Spencer taught that the interface module allows user to track (determine) information about contacts, in other words:

determining if the address corresponds to a single contact in the contact list;

determining if the address corresponds to a mailing list in the contact list;

determining if the address corresponds to a newsgroup address in the contact list;

determining if the address corresponds to an invalid email address or internet address;

determining if the address corresponds to a valid email address not found to match any addresses in the contact list.

For this rationale, claim 4 is rejected.

15. In regards to claim 5, Spencer discloses the Electronic address book interface module running over a network as in a client-server system [see Spencer col. 12, lines 61-65]. Since the interface module allows user to track (determine) information about contacts in a client-server environment, it is also:

determining if the address corresponds to an address in a contact list of at least one

server whenever it is determined the address is a valid email address not found to match

any address in the contact list.

For this rationale, claim 5 is rejected.

16. In regards to claims 6-8, and 12-14, Spencer-Holtz taught the use of iconic presentation, the parsing and tracking of email addresses. Furthermore, Holtz also discloses an icon generator [see Holtz, figure 5, col. 6, lines 9-16]. Thus, appending icons to specific addresses and addresses entities are taught by Holtz's iconic presentation and Spencer's database matching [see Spencer, col. 8, lines 31-42], identifying and verification of contacts [see Spencer, col. 4, lines 8-19, col. 4, lines 56-60, col. 6, lines 14-32, col. 6, lines 52-53] in a computer-networking environment. The uses of icons and non-text images are also disclosed in Spencer's invention even though they were not listed out in specific [see Spencer, col. 4, lines 20-36]. However, Spencer clearly states: "... icons or pictures may preferably be stored in the electronic address book database and may therefore be extracted," [see Spencer, col. 4, lines 33-35, and figure 1].

17. Further, in conventional icon-based operating systems, such as CDE (common desktop environment) or Windows-95, the objects are typically represented by object icons upon the computer display device [see Holtz, col. 4, lines 57-60], in other word, the icon is appended adjacently to the name of the data object it represented, for example, the Microsoft Word icon is appended next to the file name, or in case of an email address data type, there would have been an icon, as disclosed by Holtz, appended to the recipient.

18. In addition, Spencer discloses: "The Electronic Address Book Interface Module may comprise any electronic address book programs" [see Spencer, col. 6, lines 28-30, and figure 2]. As well known in the art, any modern electronic address book programs would contain features such as mailing lists, detection of invalid email addresses, auto-filling addresses from database.

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These features are the foundation of claims elements of the claims in this group (claims 6-8, 12-14) in conjunction with the icons elements.

19. Claim 9, as amended, presents user with an address flagging capability and user interactive capability. Spencer-Holtz discloses user interactivity in a networking environment [see Spencer, col. 2, lines 10-15, col. 12, lines 61-65], and [Holtz, col. 6, lines 58-67].

20. In regards to claim 10, as amended, Spencer-Holtz taught *wherein the act of identifying an entry in the preview pane or full message window of an email message as an email address in an incoming email message comprises initially appending an icon representing an indeterminate indicator to all email addresses in the header that are not in a "From" address field, by way of parsing predefined label (from) and iconic presentation of an address* [see Spencer, col. 4, lines 51-54, see Holtz, col. 3, lines 8-10]. As for background processing, this is a performance improvement method that utilizes processor idling cycles well known in the art at the time the invention was made.

21. In regards to claim 11, Spencer-Holtz discloses *wherein the indeterminate icon appended to addresses in the email header that are not in the From address field is replaced with an appropriate icon when the checking and marking acts are performed by parsing unrecognized labeled values and iconic presentation of addresses* [see Spencer, col. 5, lines 27-29, see Holtz, col. 3, lines 8-10].

22. In regards to claim 15, Spencer-Holtz discloses *wherein the act of manipulating comprises one of moving, deleting, or copying the object* [see Spencer, col. 11, lines 1-14, see Holtz, col. 3, lines 36-41].
23. In regards to claim 16, Spencer-Holtz discloses *wherein the act of selecting an indicator comprises an act of selecting the indicator via an activation action associated with an input device* [see Spencer, col. 7, lines 16-22, see Holtz, col. 4, lines 62-67].
24. In regards to claim 17, Spencer-Holtz discloses *the act of allowing a user to open an entry in the contact database associated with the address via an activation action associated with an input device* [see Spencer, col. 7, lines 16-22, col. 8, lines 31-42].
25. In regards to claim 18, Spencer-Holtz discloses *the act of prompting a user to create an entry associated with the address in the contact database via an activation action associated with an input device whenever such an entry does not already exist in the contact database* [see Spencer, col. 8, lines 37-42].
26. In regards to claim 19, Spencer-Holtz discloses *the act of selecting an indicator further comprises an act of displaying an appropriate contextual menu depending on the type of indicator associated with said address* [see Holtz, col. 3, lines 36-41].

27. In regards to claim 20, Spencer-Holtz discloses *the act of displaying an appropriate contextual menu further comprises adding an email address to a user's contact list and wherein an email address is added to the user's contact data base upon selection of the menu item* [see Spencer, col. 7, lines 23-31].
28. In regards to claims 21, Spencer-Holtz discloses *wherein the user has an option to open a window containing editable content associated with an email address if a contact who sent the email message is in the user's contact data base* [see Spencer, col. 6, lines 24-32, col. 8, lines 31-37].
29. In regards to claim 22, Spencer-Holtz discloses *the act of using a computer to open an item associated with the email address after looking up the item in one or more contact databases when the user double clicks on the adjacently placed indicator* [see Spencer, col. 6, lines 24-32, col. 8, lines 31-37, Holtz, col. 3, lines 8-10, Holtz, col. 4, lines 62-67].
30. In regards to claim 23, Spencer-Holtz discloses *prompting the user to create an item associated with said indicator if the address was manually entered or captured from a server* [see Spencer, col. 6, lines 45-48, Holtz, col. 3, lines 8-10, Holtz, col. 6, lines 58-67].
31. Since all the claims limitations were disclosed by the combination of Spencer-Holtz, claims 1-25 are rejected.

Response to Arguments

32. Applicant's arguments filed on 03 November 2003, Paper #7, pertaining to the combination Spencer and Holtz teachings, have been fully considered but they are not persuasive.

33. On Page 11-12, Applicant asserts: "*Holtz reference does not teach or suggest marking an email address with an indicator,*" Examiner would like to direct Applicant attention to the prior art of record, col. 3, lines 8-9 where Holtz expressly stated: "Icons representing the addressing of the e-mail message and an attachment action are displayed upon the computer display device."

Holtz's description in deed described an icon representing an email address, and an icon representing an attachment. Also see Holtz, Col. 5, lines 49-52 and Col. 6, lines 38-44 where the indication of a specific data type (e.g., email address) is achieved using iconic representation.

34. Applicant argues on Page 13 that: "*Holtz is not teaching the appending of an indicator icon to an email address. Rather, it teaches the representation of an action.*" It will be assumed that "*appending of an indicator icon to an email address*" implies a direct correlation between an icon and an email address. Applicant admits: "*the objects [entities of a particular data type, i.e., email addresses, attachments] that are acted upon are also represented by an icon...*" in the following paragraph. By this admission, it is established that Holtz disclosed an icon, which represented a particular data type, i.e., email address. Examiner would like to concur with Applicant's own admission on this fact by reciting Holtz's disclosure on Col. 2, lines 61-62: "The action is performed upon the object by dragging the object's icon representation, also displayed upon the computer display device, to the icon representation of the action."

35. It is further argued on Page 14 that the icon disclosed in Holtz's prior art of record is not an "object" icon. It is well known in the art that an object is an entity (class, variable) that comprises of data and/or methods (routines, functions) that operate upon the object data. The icon disclosed in Holtz's invention, in fact, contained data: "an object of a particular data type," [see Holtz, col. 2, line 59]. This icon is further provided with functions, for example, user can click or drag the icon. Thus, the icon in Holtz's disclosure meets the definition of an object, since minimally, this object designates an icon and an associated address.

36. The word "*appended*" seems to be the center of the argument in the next paragraph on the same page. "*Appended*" is cited in claim 6, a dependent claim. While Holtz did not expressly state: "*an object icon be appended to an email address*," as asserted by Applicant on Page 14. In conventional icon-based operating systems, such as CDE (common desktop environment) or Windows-95, the objects are typically represented by object icons upon the computer display device [see Holtz, col. 4, lines 57-60], in other word, the icon is appended adjacently to the name of the data object it represented, for example, the Microsoft Word icon is appended next to the file name, or in case of an email address data type, there would have been an icon, as disclosed by Holtz, appended adjacently to the recipient.

37. Applicant's arguments, see Pages 15-18 of Amendment Paper #7, filed on 03 November 2003 with respect to claims 1-3, 12, 15, 18, 20, 24 and 25 pertaining to the combination Yahoo Mail and Nielsen teachings, have been fully considered and are persuasive. The rejection of claims 1-3, 12, 15, 18, 20, 24 and 25 has been withdrawn.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lambert L. Tran whose telephone number is (703) 305-4663. The examiner can normally be reached on 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

MARC D. THOMPSON
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PRIMARY EXAMINER

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January 23, 2004

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